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10/601,645	06/24/2003	Takaya Matsuishi	238486US2DIV	1282

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EXAMINER	
NGUYEN, MERILYN P	
ART UNIT	**PAPER NUMBER**
2163	

NOTIFICATION DATE	DELIVERY MODE
11/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/601,645	MATSUISHI	
	Examiner	Art Unit	
	Merilyn P. Nguyen	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *55-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *55-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09632212.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *detailed action*.

DETAILED ACTION

1. In response to the communication dated 08/17/2007, claims 55-69 are pending in this office action.

2. This application is a Division of 09/632,212 filed on August 03, 2000 now patent number 6,782,387.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/17/07 has been entered.

Acknowledges

4. Receipt is acknowledged of the following items from the Applicant:

- The applicant's amendment has been considered and made of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 55, 60 and 65 stand rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 55, 60 and 65 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed on 02/15/2007. In that paper, applicant has stated at page 10,

"The correct result should be expressed as A couple B = C, and then A-1 couple A-2 = A, where as the result of the processing, A is renamed to A-1, B is renamed to A-2, and C is renamed to A. A and B are renamed based on the new name assigned to the result of the coupling of the document data" and this statement indicates that the invention is different from what is defined in the claim(s). For example, the claimed limitation of "a document name generating part configured to determine a name of one of the plurality of document data used to create the first document data, to assign the determined name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data" can be understood as A couple B = C and then the name of document C is set to be the name of document A as A couple B = A and then next step is renaming the plurality of document data (A&B) to include the name assigned to the first document data (now is A). The result of A couple B = C after processing would have been A couple A = A (or it can be AA couple AB = A), which would appear to be different from which applicant regard as invention because no way that the claim can product A-1 couple A-2 = A.

6. Claims 55-69 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 57, 62 and 67, the claim recites, "wherein the document name generating part is further configured to use indexes indicating an order in the first document data, as the names of the plurality of document data from which the first document data is thus

obtained" which renders the claim indefinite because it seems to be contradicted with the limitation of claim 55. Claim 55 recites the name assigned to the first document data is used as the names of the plurality of document data used to create the first document data while claim 57 uses indexes as the names of the plurality document data. It is understood that the names of the plurality of document data is now renamed to numbers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 55-69 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (US 5,960,444), in view of Schloss (US 6,249,844).

Regarding claims 55, 60 and 65, Jackson discloses a document data handling apparatus for coupling a plurality of document data, wherein each of the plurality of document data includes a plurality of types of files (Fig. 1), said apparatus comprising:

- a document data coupling control part configured to control a document data coupling process in which the plurality of document data managed by a document managing part are coupled together to form first document data (see col. 3, lines 25-35); and

Jackson teaches a name generating part (See Fig. 3 and Fig. 7) to generate title information (See col. 4, lines 9-15) and bookfile name (See col. 7, lines 3-9). However, Jackson is silent as to

teach assigning the name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data. On the other hand, Schloss teaches a name creator for fragment document (See col. 7, line 29 to col. 8, line 3, Schloss et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the name creator of Schloss into the system of Jackson to generate a document name of the first document data, the motivation would have been to enhance the ability of generating the document name at ease by having separate name creator software.

Jackson in incorporation with Schloss is silent as to assigning the name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to generate any name for documents, for example name of the first document and names of plurality of document data as instant invention, by changing filenames as desire and to assign the name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data. The subjective interpretation of the names does not patentably distinguish the claimed invention. The motivation would have been to uniquely identify the related document data by renaming all the names of document data in an easy managed and recognized format.

Regarding claims 56, 61, and 66, Jackson/Schloss discloses manage correspondence between the document name of the first document data and the names of the plurality of document data from which the first document data is thus obtained (See col. 4, line 58-67 and col. 5, lines 41-55, Jackson et al.).

Regarding claims 57, 62 and 67, Jackson/Schloss discloses wherein the document name generating part is further configured to use indexes indicating an order in the first document data as the names of the plurality of document data from which the first document data is thus obtained (See col. 5, line 38 to col. 6, line 15, Jackson et al.).

Regarding claims 58, 63 and 68, Jackson/Schloss discloses wherein the document coupling control part is further configured to control, upon coupling document data together, an order of the plurality of document data from which the first document data is thus obtained (See col. 5, line 38 to col. 6, line 15, Jackson et al.).

Regarding claims 59, 64 and 69, Jackson/Schloss discloses a display control part configured to display a page through which an instruction by a user for coupling document data together is received (See Figs 2-6, Jackson et al.).

Response to Arguments

8. Applicant's arguments filed 08/17/2007 have been fully considered but they are not persuasive.

Response to Applicant's Remarks on 112, 1st paragraph rejection:

Applicants argues,

"With respect to the comments on page 3 of the outstanding Office Action, Applicants A-1 and A-2 in their Example equates to AA and AB in the Examiner's example. In the Examiner's example, A is renamed AA and B is renamed AB. Each of AA and AB include A in its name. In Applicants example, A is renamed to A-l, and B is renamed to A-2. Each of A-1 and A-2 include A in its name. The Examiner's and Applicants' examples are the same, just the notation is different."

Examiner respectfully disagrees. Applicants A-1 and A-2 do not equate to AA and AB in the Examiner's example of interpretation of the claimed language. A-1 and A-2 include both alphabets and indexes while the claimed limitation can only produce letters. The Examiner once again respectfully interprets the claimed limitation herein.

"a document name generating part configured to determine a name of one of the plurality of document data (for example name A of document data named A and B) used to create the first document data (A+B=C where in C is the first document data), to assign the determined name (A) of one of the plurality of document data (A and B) used to create the first document data (C) to the first document data (A+B=A, wherein C now is replaced with the determined name A), and to rename the plurality of document data (A and B) used to create the first document data so as to include the name assigned to the first document data (AA+BA=A or AA+AB=A)". Thus,

AA+BA=A or AA+AB=A which would appear to be different from which applicant regard as invention because no way that the claim can product A-1 couple A-2 = A.

Claims 57, 62 and 67 recites "wherein the document name generating part is further configured to use indexes indicating an order in the first document data as the names of the plurality of document data from which the first document data is thus obtained". The claims introduce indexes to indicate an order in the first document. However, the claims only claiming replacing the names of the plurality of document data from which the first document data is thus obtained with indexes instead including indexes with the names of the plurality of document from which the first document data is thus obtained. Therefore, even though claim 57 is added to claim 55, for example, the claim (55) still cannot produce both names and indexes as the Applicants regard as their invention.

Applicant states (Remark, page 7, paragraph 4), "In non-limiting embodiments described in the specification, **indexes are added to the document names**. Paragraph [0374] of the published version of the specification states "the section names are automatically changed into ones consisting of the document name and indexes added thereto." Thus, there can be both names and indexes, and Claims 57, 62, and 67 are not inconsistent with their respective independent claims." However, claims 57, 62 and 67 does not recite indexes are added to the document names so that the section names (document data as claimed) changed into ones consisting of the document name and indexes.

Response to Applicants Remark on 103 Rejection:

Applicants argue that the last Office Action fails to show that the prior art disclose each and every element of claim 55. The Examiner respectfully disagrees. The Examiner rejection claim 55 under 103 Rejection, therefore some of the limitations in the claims that Jackson do not disclose. The Examiner uses Jackson in combination with Schloss and ordinary skill in the art to show the obviousness of the claimed limitations. Thus, the claims are suggested by Jack, in view of Schloss. Jackson and Schloss both generating names for sections of document, thus one having ordinary skill in the art would have understood that names of the sections of document can be generated as user desires thus generating different names with the prior art does not give patentable weight to the Applicant invention.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN
November 21,2007

11/25/07
Hung Vy
For SPE Don Wong